

Application No.	Applicant(s)	
10/829,631	HODGES ET AL.	
Examiner	Art Unit	
Adrienne C. Johnstone	1733	

Status of Application: *new*

(3) _____.

(4) _____.

Time: _____

☒ Telephonic
☐ Video Conference
☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

Part I.

Claims discussed:
all

Prior art documents discussed:
all

Part II.

SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:
See Continuation Sheet

Part III.

- ☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.
- ☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.

(Applicant/Applicant's Representative Signature – if appropriate)

Continuation of Substance of Interview including description of the general nature of what was discussed: The examiner faxed to applicants on March 28, 2005 a proposed amendment which would place the application for allowance (see attachment); after discussions with applicants the examiner faxed to applicants on April 14, 2005 another proposed amendment which would place the application in condition for allowance (see attachment); after further discussions with applicants agreement was not reached and the examiner advised applicants that a first Office action on the merits would be mailed to applicants..



Patent Technology Center 1700

Facsimile Transmission

To:	Name:	Paul Conover
	Company:	Knobbe Martens Olsen & Bear LLP
	Fax Number:	949-760-9502
	Voice Phone:	949-760-0404
From:	Name:	Adrienne Johnstone
	Official Fax Number:	(703) 872-9310
	Official After Final Fax Number:	(703) 872-9311
	Voice Phone:	571-272-1218

37 C.F.R. 1.6 sets forth the types of correspondence that can be communicated to the Patent and Trademark Office via facsimile transmissions. Applicants are advised to use the certificate of facsimile transmission procedures when submitting a reply to a non-final or final Office action by facsimile (37 CFR 1.8(a)).

Fax Notes:

Please review and reply to the proposed examiner's amendment as soon as possible.

Date and time of transmission: Thursday, April 14, 2005 3:22:16 PM
Number of pages including this cover sheet: 08

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a tire whose inboard tire wall has a bead and whose outboard wall has a bead, a wheel protector, and a flange seat, classified in class 152, subclass 523.
 - II. Claims 19-30, drawn to a tire whose outboard tire wall width is at least 3-1/2 inches and whose flange seat has a width of between about one-quarter and about one-half as large as the width of the outboard tire wall and is configured to receive a flange with an outboard face attached to a wheel mounted within the tire without obscuring the outboard face of the flange, classified in class 152, subclass 454.
 - III. Claims 31-42, drawn to a tire whose inboard tire wall has a bead and whose outboard tire wall has a flange seat and a bead, at least a portion of the outboard tire wall radially outward of the flange seat extending further in the outboard direction than any portion of the tire wall in the flange seat, the width of the flange seat being at least about 1-1/2 inches and at least about 1/2 inch greater than the width of the outboard bead, classified in class 152, subclass 544.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II-III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as a tire without the particular features of Inventions II and III, Invention II has separate utility such as a tire without the particular

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features of Inventions I and III, and Invention III has separate utility such as a tire without the particular features of Inventions I and II. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Paul Conover on January 26, 2005 a provisional election was made without traverse to prosecute the invention of Group III, claims 31-42. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Examiner's Amendment

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with *** on

The application has been amended as follows:

In the specification

paragraph 0001 has been rewritten as --

[0001] This application is a continuation of U.S. Application No. 10/266,040, filed October 7, 2002, now U.S. Patent 6,820,669, issued November 23, 2004, which is incorporated herein by reference.

-- to update the status of the parent application;

paragraph 0047 line 4, to provide antecedent basis in the specification for the ledge language added to claim 31, after "ledge 108" has been inserted -- defining the inner diameter of the wheel protector 102 and in this embodiment extending substantially in the tire axial direction -- ;

paragraph 0049 line 10, to provide antecedent basis in the specification for the flange seat extension language added to claim 31, after the period has been inserted the sentence -- In the illustrated embodiment the flange seat 109 extends substantially outward beyond the outboard bead 100. -- ;

paragraph 0049 line 12, to provide antecedent basis in the specification for the claim 31 flange seat width, before the period has been inserted -- and can be at least about 1-1/2 inches -- ;

paragraph 0049 line 18, to provide antecedent basis in the specification for the flange seat location language added to claim 31, after the period has been inserted the sentence -- In this embodiment the flange seat is located further axially inward than any part of the outboard tire wall 92 which is outwardly adjacent to the portion of the outboard tire wall 92 including the wheel protector 102. -- .

In the claims

non-elected invention claims 1-30 have been cancelled;

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claim 31, to eliminate new matter, to distinguish over the prior art, and to clarify the definition of the terms "flange seat" and "bead" as set forth in the specification and drawings (see paragraphs 0047-0051 and Figure 11), has been rewritten as --

31. (currently amended) A tire for enhancing a simulated appearance of a large-diameter wheel mounted within a low-profile tire, the tire comprising:

an outboard tire wall with a wheel protector, a ledge defining the inner diameter of the wheel protector and extending substantially in the tire axial direction, and a flange seat [and] including an outboard bead, an inboard tire wall with an inboard bead, and a tread therebetween;

the beads being comprised of indented rings formed on the inner radial edges of the respective inboard and outboard tire walls;

the wheel protector extending in the outboard direction further than any portion of the outboard tire wall in the flange seat;

the flange seat having an inner diameter, an outer diameter, and a width therebetween, the inner diameter being the inner diameter of the outboard tire wall and the outer diameter being the diameter of the ledge, the flange seat extending substantially outward beyond the outboard bead and being configured to receive an extended flange attached to the wheel to simulate a low-profile tire mounted on a large-diameter wheel [and the outboard bead having an inner diameter, an outer diameter, and a width therebetween, wherein at least a portion of the outboard tire wall in a region positioned radially outwardly from the flange seat extends further in the outboard direction than any portion of the tire wall in the flange seat];

the flange seat being located further axially inward than any part of the outboard tire wall which is outwardly adjacent to the portion of the outboard tire wall including the wheel protector;

and

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the width of the flange seat being at least about 1-1/2 inches[, and at least about 1/2 inches greater than the width of the outboard bead].

-- ;

claim 32, to provide proper antecedent basis, has been rewritten as --

32. (currently amended) The tire of claim 31, wherein the respective inboard and outboard beads each have an inner diameter, an outer diameter, and a width therebetween, and the inboard bead and the outboard bead have substantially the same width.

-- ;

claim 33 line 2, to eliminate indefiniteness (the location of the boundary between the outboard tire wall and the tread is not defined), "outboard tire wall" has been changed to -- tire -- ;

claim 34 has been cancelled (new matter).

Reasons for Allowance

7. The following is an examiner's statement of reasons for allowance: Macmillan (2,037,640: see Figure 3) and Boileau (3,631,913) disclose examples of the prior art tire similar to the claimed tire but wherein the flange seat does not extend substantially outward beyond the outboard bead. Boileau et al. (4,061,171: see Figure 3) and Sakamoto et al. (6,418,993 B1) disclose examples of the prior art tire similar to the claimed tire but wherein the ledge does not extend substantially in the tire axial direction. Yeager et al. (4,356,985), Shurman (4,809,757), and Japanese Patent Application 3-228903 A disclose examples of the prior art tire similar to the claimed tire but wherein the flange seat is not located further axially inward than any part of the outboard tire wall which is outwardly adjacent to the portion of the outboard tire wall including the wheel protector. Japanese Patent Application 55-91409 A discloses an example of the prior art tire similar to the claimed tire but wherein the flange seat width is not at least about 1-1/2 inches. Butler (796,894) and Swiss Patent

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393 117 are cited of interest for disclosing tire and wheel assemblies with high rim flanges. The prior art of record thus fails to disclose or suggest applicants' tire, including the particular combination of the flange seat extending substantially outward beyond the outboard bead, the ledge extending substantially in the tire axial direction, the flange seat being located further axially inward than any part of the outboard tire wall which is outwardly adjacent to the portion of the outboard tire wall including the wheel protector, and the flange seat width being at least about 1-1/2 inches, in the claimed environment.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571)272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571)272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

Adrienne Johnstone

March 28, 2005



Patent Technology Center 1700

Facsimile Transmission

To:	Name:	Paul Conover
	Company:	Knobbe Martens Olsen & Bear LLP
	Fax Number:	949-760-9502
	Voice Phone:	949-760-0404
From:	Name:	Adrienne Johnstone
	Official Fax Number:	(703) 872-9310
	Official After Final Fax Number:	(703) 872-9311
	Voice Phone:	571-272-1218

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Fax Notes:

Please review and reply to the proposed examiner's amendment at your earliest convenience.

Date and time of transmission: Monday, March 28, 2005 7:08:52 PM
Number of pages including this cover sheet: 07

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a tire whose inboard tire wall has a bead and whose outboard wall has a bead, a wheel protector, and a flange seat, classified in class 152, subclass 523.
 - II. Claims 19-30, drawn to a tire whose outboard tire wall width is at least 3-1/2 inches and whose flange seat has a width of between about one-quarter and about one-half as large as the width of the outboard tire wall and is configured to receive a flange with an outboard face attached to a wheel mounted within the tire without obscuring the outboard face of the flange, classified in class 152, subclass 454.
 - III. Claims 31-42, drawn to a tire whose inboard tire wall has a bead and whose outboard tire wall has a flange seat and a bead, at least a portion of the outboard tire wall radially outward of the flange seat extending further in the outboard direction than any portion of the tire wall in the flange seat, the width of the flange seat being at least about 1-1/2 inches and at least about 1/2 inch greater than the width of the outboard bead, classified in class 152, subclass 544.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II-III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as a tire without the particular features of Inventions II and III, Invention II has separate utility such as a tire without the particular

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features of Inventions I and III, and Invention III has separate utility such as a tire without the particular features of Inventions I and II. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Paul Conover on January 26, 2005 a provisional election was made without traverse to prosecute the invention of Group III, claims 31-42. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Examiner's Amendment

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with *** on ***.

The application has been amended as follows:

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In the specification

paragraph 0001, to update the status of the parent application, has been rewritten as --

[0001] This application is a continuation of U.S. Application No. 10/266,040, filed October 7, 2002, now U.S. Patent 6,820,669, issued November 23, 2004, which is incorporated herein by reference.

--;

paragraph 0049, to provide antecedent basis in the specification for the claim 31 flange seat width, in line 12 before the period has been inserted -- and can be at least about 1-1/2 inches -- .

In the claims

non-elected invention claims 1-30 have been cancelled;

claim 31, to eliminate new matter, to distinguish over the prior art, and to clarify the definition of the terms "flange seat", and "bead" as set forth in the specification (paragraphs 0047-0051), has been rewritten as --

31. (currently amended) A tire for enhancing a simulated appearance of a large-diameter wheel mounted within a low-profile tire, the tire comprising:

an outboard tire wall with a wheel protector, a ledge, and a flange seat [and] including an outboard bead, an inboard tire wall with an inboard bead, and a tread therebetween;

the beads being comprised of essentially indented rings formed on the inner radial edges of the respective inboard and outboard tire walls;

the wheel protector extending in the outboard direction further than any portion of the outboard tire wall in the flange seat;

the flange seat having an inner diameter, an outer diameter, and a width therebetween, the inner diameter being the inner diameter of the outboard tire wall and the outer diameter being the

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diameter of the ledge, the flange seat being substantially more rigid than the remainder of the tire
[and the outboard bead having an inner diameter, an outer diameter, and a width therebetween,
wherein at least a portion of the outboard tire wall in a region positioned radially outwardly from the
flange seat extends further in the outboard direction than any portion of the tire wall in the flange
seat]; and

the width of the flange seat being at least about 1-1/2 inches[, and at least about 1/2 inches
greater than the width of the outboard bead].

-- ;

claim 32, to provide proper antecedent basis, has been rewritten as --

32. (currently amended) The tire of claim 31, wherein the respective inboard and outboard
beads each have an inner diameter, an outer diameter, and a width therebetween, and the inboard
bead and the outboard bead have substantially the same width.

-- ;

claim 33 has been cancelled (now contradicts claim 31);

claim 34 has been cancelled (new matter, and now contradicts claim 31).

Reasons for Allowance

7. The following is an examiner's statement of reasons for allowance: Casanova et al.
(4,856,572) and Swiss Patent 393 117 (determined through oral translation) disclose examples of the
prior art tire similar to the claimed tire but wherein the tires are symmetrical such that flange seats
having substantially the same rigidity are provided in both the inboard and outboard tire walls,
thereby not meeting the requirement that the flange seat in the outboard tire wall be "substantially
more rigid than the remainder of the tire". Olgner et al. (3,204,681), Yeager et al. (4,356,985), and
Demor, III et al. (4,926,918) all disclose examples of the prior art tire similar to the claimed tire and

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having a flange seat only in the outboard tire wall but wherein other parts of the tire are substantially as rigid as the flange seat, thereby not meeting the requirement that the flange seat be "substantially more rigid than the remainder of the tire". The prior art of record thus fails to disclose or suggest applicants' tire, including the particular outboard tire wall flange seat being substantially more rigid than the remainder of the tire, in the claimed environment.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571)272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571)272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1733

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Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

Adrienne Johnstone

March 28, 2005